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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,658	05/27/2005	Jens Roder	BE 60146 (142-163 PCT US)	9838
28249 7590 02/13/2007 DILWORTH & BARRESE, LLP 333 EARLE OVINGTON BLVD. SUITE 702 UNIONDALE, NY 11553			EXAMINER LAO, MARIALOUIA	
			ART UNIT	PAPER NUMBER
			1621	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

78

Office Action Summary

Application No.

10/536,658

Applicant(s)

RÖDER ET AL.

Examiner

MLouisa Lao, Ph.D.

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-39 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-28 is/are allowed.
- 6) ☐ Claim(s) 20-23 and 29-39 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/27/05</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 20, 21 and 29-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Dakternieks et al. *Synthesis, structure and reactions of [(BuSn)₁₂O₁₄(OH)₆]Cl₂.2H₂O: solution studies using ¹¹⁹Sn NMR and electrospray mass spectrometry*. J.OrgMet.Chem, 476(1994) 33-40.

3. Dakternieks et al. teach the compound [(BuSn)₁₂O₁₄(OH)₆]Cl₂.2H₂O.

4. While the instant application is directed to a chemical composition containing a tin compound according to formula I, as shown: $[(R^1Sn)_l(OH)_{m-n}(OR^2)_nO_o]^{p+}A^{q-}$, with the defined substituents, as recited.

5. Dakternieks et al. reads on the instant claims since these would correspond to R1 = butyl, l = 12, m = 6, n = 0, o = 14, p = 2, A = Cl and q = 1. See the structure elucidated on page 36 column 2 Fig.5.

6. Further, Dakternieks et al. in page 33 column 1 paragraph 1 teaches that organotin (IV) oligomers exhibit catalytic activity in transesterification and polymerization processes.

7. Thus, it is clear that Dakternieks et al. anticipates the composition containing the catalytic composition and the method of use of said composition, as recited.

8. Claims 38 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Tindale (US5419936, US'936).

Art Unit: 1621

9. Dependent claims 38 and 39 are directed to a composition comprising polyester and a polyester or resin composition.
10. Tindale in column 6 claims 1-6 teaches the composition of polyethylene terephthalate, which is a polyester, for bottles.
10. Thus, Tindale reads on claims 38 and 39.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

12. Claim 21 recites the limitation " OH", a linear, branched or cyclic alkyl group, aryl carboxy group or alkoxy group each having 1 to 12 carbon atoms" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim. The substituents recited are monovalent; whereas q=2 in claim 20.

Allowable Subject Matter

13. Claims 24-28 are allowed.
14. The following is a statement of reasons for the indication of allowable subject matter: the steps for the alkoxylation of the tin compound, as recited in claim 24, has neither been disclosed or taught in prior art.

Art Unit: 1621

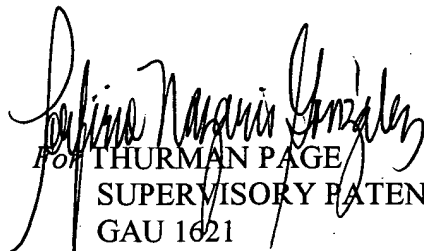
Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MLouisa Lao, Ph.D. whose telephone number is 571-272-9930. The examiner can normally be reached on 8:30am to 5:30pm Mondays to Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

`mll 02022007
MLouisa Lao, Ph.D.
Examiner
Art Unit 1621


THURMAN PAGE
SUPERVISORY PATENT EXAMINER
GAU 1621